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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,245	01/15/2002	Sarvajit Thakur	INS-101	9222

7590 09/13/2005

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EXAMINER
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BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/050,245

Applicant(s)

THAKUR ET AL.

Examiner

Igor Borissov

Art Unit

3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                        |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 6/22/2005 has been entered.

### ***Response to Amendment***

Amendment received on 6/22/2005 is acknowledged and entered. Claims 1 and 2 have been amended. Claim 9 has been canceled. Claims 1-8 are currently pending in the application.

### ***Claim Objections***

Claims 1-8 are objected to because of the following informalities:

Claim 1 recite the following limitation (Claims amendment; page 6, line 5): *"providing a core government immigration and naturalization application and servicing center system"*, which can be understood as providing government facility, which is not a part of invention.

Furthermore, the examiner objects the following language (page 6, 12-13, 22-23): *"completing any of the various procedures related to immigration and naturalization"* as being indefinite. The examiner suggests the following phrase: *"completing necessary existing procedure or procedures related to immigration and naturalization"*. Same reasoning is applied to the phrase (page 6, line 15): *"any of the various government immigration and naturalization forms"*.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the following limitation: *"wherein any of the various government procedures related to immigration and naturalization which the user is eligible for can be initiated, performed in part without making administrative errors"*, which is vague and indefinite. First, it is not clear what type of errors the Applicant considers "administrative"; definitions or description of such errors are not provided. Second, if absence of errors is provided only for the part of said procedure, than completion of a whole procedure would still, possibly, leave space for errors. Therefore, said limitation is confusing.

Claim 8 refers to itself, which is confusing.

The remaining Claims are rejected as being dependent on the rejected Claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meltzer et al. (US 6,366,925) in view of Lewis et al. (US 2002/0029194).**

Meltzer et al. (hereinafter Meltzer) teaches a method for conducting legal services, comprising:

**Claims 1.** Providing a system for processing immigration and naturalization applications (C. 5, L. 30-40); electronically accessing said system over a computer network (C. 5, L. 30-40); entering preliminary screening and qualifying data via a graphical user interface (C. 6, L. 24-37); electronically determining eligibility of the user for required procedure or procedures related to immigration and naturalization based on preliminary screening and qualifying data (C. 8, L. 48-53); identifying (selecting) INS form required for the user (C. 12, L. 6-8, 61-63); automatically matching the responses to a questionnaire and applicable questions on the INS forms identified (C. 12, L. 38-40, 59-64); and electronically sending the completed forms to the particular agency (C. 12, L. 39-55).

Meltzer does not specifically teach that said step of selecting INS form required for the user is performed automatically.

Lewis et al. (Lewis) teaches a method and system for managing transactions over an electronic network, wherein, upon receiving a request, the system accesses a database which stores laws, requirements and customs for documents and procedures of all jurisdictions and potential participants, and automatically creates the interface, forms and documents unique to the transaction (Abstract; [0109]).

It would have been obvious to one having ordinary skill in art the time the invention was made to modify Meltzer to include that said step of selecting INS form required for the user is performed automatically, as disclosed in Lewis, because it would advantageously allow to automate the existing slow and paper intensive procedures (Lewis, [0017]).

**Claim 2.** Meltzer teaches all the limitations of claim 2, except specifically teaching *printing* the completed forms.

Official notice is taken that printing from the Internet is well known.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Meltzer to include printing the completed forms from the website, because it would advantageously provide user with a hard copy of the filled forms if the electronic system fails.

Furthermore, Meltzer teaches:

**Claim 3.** Making electronic payments for required fees (C. 14, L. 8-9).

**Claims 4-5.** Accessing the website over the Internet (C. 4, L. 62 – C. 5, L. 2; L. 39-40).

**Claim 6.** Electronically providing instructions to be undertaken by the client (C. 7, L. 15).

**Claim 7.** Determining eligibility of the user by comparing qualifying data to INS requirements (C. 8, L. 34-36).

**Claim 8.** Creating an account (log) containing qualifying data particular to the user (C. 9, L. 39-60).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

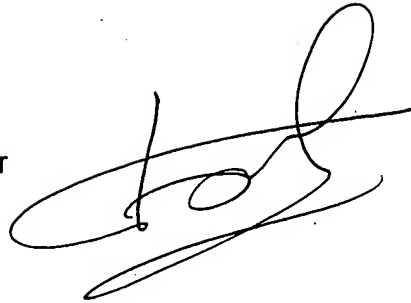
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Igor Borissov  
Patent Examiner  
Art Unit 3639

A handwritten signature in black ink, consisting of a series of loops and a long horizontal stroke at the bottom.

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9/03/2005